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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional).

00041

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on 8-24-05

Signature [Signature]

Typed or printed name Peter R. Martinez

Application Number

09/480,837

Filed

January 10, 2000

First Named Inventor

Stephan Gehring

Art Unit

2664

Examiner

Chirag G. Shah

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record. 42,845  
Registration number

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34

[Signature]  
Signature

Peter R. Martinez

Typed or printed name

760-607-0844

Telephone number

August 24, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Docket No.: 00041

AFB  
ZFW

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:	)	Group Art Unit:	2664
	)		
Stephan Gehring et al.	)	Examiner:	Chirag G. Shah
	)		
Serial No.: 09/480,837	)		
	)		
Filed: January 10, 2000	)		
	)		
For: AN APPARATUS AND	)		
METHOD FOR	)		
MANAGING VARIABLE-	)		
SIZE DATA SLOTS WITH	)		
TIMESTAMP COUNTERS	)		
WITHIN A TDMA FRAME	)		

Carlsbad, California  
August 24, 2005

MAIL STOP AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**NOTICE OF APPEAL**  
**&**  
**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir:

In response to the Final Office Action dated June 28, 2005, a Notice of Appeal, a Pre-Appeal Brief Request for Review, and accompanying arguments are submitted for consideration. These documents are submitted less than two months after the mailing of the Final Office Action.

08/29/2005 MAHMED1 00000013 09480837

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## **REMARKS**

These remarks are submitted for review and consideration during the Pre-Appeal Brief Review. Claims 1-20 are pending and finally rejected, and can be found in Applicant's March 15, 2005 Response. No other appeals or interferences exist which relate to the present application or appeal. No amendments are outstanding.

### **Summary of the Invention**

As set forth in claim 1, and similarly in claims 9, 14 and 20, the invention is an ultra wide band network that includes a master device and a plurality of slave devices in communication with the master device. Communication between the master and slave devices is accomplished using ultra wide band signals, or pulses. A Medium Access Control (MAC) protocol is employed for transmission and reception of network packets among the devices. These packets comprise a Time Division Multiple Access frame having a start-of-frame section, a command section, a data slot section containing a plurality of variable length slots, a synchronization slot, and a timestamp slot.

### **Prosecution History of the Invention**

Independent claims 1, 9, and 14 were first amended in Applicant's first Response filed July 15, 2003, that responded to a U.S.C. § 103(a) rejection. The amendment to claim 1 was as follows:

1. An ultra wide band network, comprising: ~~In a network having~~  
a master device and a plurality of slave devices in network communication with said master device, the communication comprising a multiplicity of ultra wide band signals;  
a Medium Access Control layer protocol for transmission and reception of network packets, comprising:  
a Time Division Multiple Access frame definition having,  
a start-of-frame section,  
a command section,  
a data slot section containing a plurality of variable length slots,  
a synchronization slot, and  
a timestamp slot.

The claimed ultra wide band network is disclosed and supported in U.S. patent 6,597,683 (the '683 patent), which is incorporated by reference in the present application.

After two subsequent Office Actions that rejected the claims under U.S.C. § 103(a), a telephonic interview was conducted on August 27, 2004. The Examiner described the interview as follows:

"Applicant provided explanation with a respect to transmission of multiplicity of ultra wideband signals in a TDMA frame in the invention in attempt [sic] to distinguish that from the prior art of record. No agreement was reached."

In response to the Examiner's questions and comments, Applicant amended the claims a second time in a September 7, 2004 Response, with claim 1 amended as follows:

1. An ultra wide band network, comprising:
  - a master device and a plurality of slave devices in network communication with said master device, the communication using a Time Division Multiple Access frame comprising a multiplicity of ultra wide band signals;
  - a Medium Access Control layer protocol for transmission and reception of network packets, comprising:
    - a Time Division Multiple Access frame definition having,
    - a start-of-frame section,
    - a command section,
    - a data slot section containing a plurality of variable length slots,
    - a synchronization slot, and
    - a timestamp slot.

The Examiner then issued a 4<sup>th</sup> Office Action, now rejecting the claims under 35 U.S.C. § 112, 1<sup>st</sup> paragraph. Applicant responded on March 15, 2005, and the Examiner issued a Final Office Action.

## **Issue**

Whether claims 1, 9, 14 and 20 comply with the written description requirement under 35 U.S.C. § 112, 1<sup>st</sup> paragraph.

## **Argument**

The present application incorporates U.S. patent 6,597,683 (the '683 patent) by reference. A paragraph from the '683 patent is reproduced below:

"The MAC protocol of the present invention may be utilized in various network configurations and topologies including, for example, guided or wired media as well as unguided or wireless media. The MAC protocol is particularly advantageous in wireless network configurations because of the error-correction and communication management features provided by the invention. Such an

illustrative wireless network is a synchronous wireless network comprising a plurality of transceiver devices transmitting and receiving pulses using a baseband or "ultra wide band" transport. Under this network configuration the MAC protocol and method of the present invention provide communication management, flow control, and failure-recovery for the shared air transport medium." [emphasis added]

The underlined section discloses a network comprised of a plurality of transceiver devices transmitting and receiving ultra wide band pulses. The present application as well as the '683 patent disclose a network that employs a MAC protocol that includes TDMA frames. Applicant claims that the TDMA frames are transmitted among the devices by using ultra wide band signals, or pulses.

First, Applicant notes that "[t]here is a strong presumption that an adequate written description of the claimed invention is present when the application is filed." M.P.E.P. 2163 IA.

"While there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure." M.P.E.P. 2163 IB.

In this case, "ultra wide band" is **expressly** supported in the originally-filed '683 patent that is incorporated by reference into the present application. **The analysis should stop here, as each and every claim element is expressly supported in the present application, or in the filed '683 patent that is incorporated by reference into the present application**

However, in an effort to reach a resolution of this case, Applicant continues:

In the June 28, 2005, Response to Arguments section, the Examiner supports his rejection by stating that the inventor did not have "possession" of the claimed invention. "Possession" of the claimed invention is required by U.S.C. § 112, 1<sup>st</sup> paragraph.

What does "possession" of the invention mean?

"The disclosure must convey to those skilled in the art that applicant has **invented** the subject matter claimed." *In re Kaslow*, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983) (emphasis added)

Invention is defined by the claims. Each and every element found in Applicant's claims can be found in the present application, or in the '683 patent that is incorporated by reference into the present application.

"It is "not a question of whether one skilled in the art *might* be able to construct the patentee's device from the teachings of the disclosure . . . Rather, it is a question whether the application necessarily discloses that particular device." *Jepson v. Coleman*, 314 F.2d 533, 536, 136 USPQ 647, 649-50 (CCPA 1963) (emphasis in original).

Thus, the description requirement only requires disclosure of the device. Again, each and every element found in Applicant's claims can be found in the present application, or in the '683 patent that is incorporated by reference into the present application.

Another way to examine the description requirement is to look at actual facts in specific cases. For example, in *Enzo Biochem Inc. v. Gen-Probe Inc.*, 296 F.3<sup>rd</sup> 1315, 63 USPQ2d 1609 (Fed. Cir. 2002), a very recent case, the claimed nucleotides were characterized in the specification only by biological activity or function. Although they had been actually reduced to practice and a bacterial host containing the material had been deposited at the American Type Culture Collection, the nucleotide had not been sequenced and therefore no structural description appeared in the specification. However, the Federal Circuit determined that reference in the specification to a deposit in a public depository constitutes an adequate description of the deposited material sufficient to comply with the written description requirement.

Thus, disclosing function without disclosing actual structure is sufficient to meet the description requirement.

Applicant not only discloses the function of transmitting TDMA frames using ultra wide band signals, but also discloses the structure of the TDMA frame, the MAC protocol and the ultra wide band network.

In view of the above discussion, Applicant respectfully requests that the Examiner withdraw his rejection of claims 1-20. Should any issues remain unresolved, the Examiner is invited to telephone the undersigned.

Respectfully submitted,



Peter R. Martinez  
Attorney for Applicant(s)  
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